

# Notice of Allowability

## Application No.

09/990,389

## Examiner

Andrea D Small

## Applicant(s)

NISHIYAMA ET AL.

## Art Unit

1626

### -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to papers filed 7/21/2003.
2. ☒ The allowed claim(s) is/are 1-5, 13, 17 and 21-22, renumbered 1-9.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

- |   |   |
|---|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)   | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>9/5</u> . |
| 5 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. <u>7/21</u> . | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                        |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material      | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance       |
|   | 9 <input type="checkbox"/> Other _____.   |

## **DETAILED ACTION**

### ***I. Papers Received:***

- (a) Applicants response filed 07/21/2003 has been received and entered into the file.
- (b) The duplicate copy of the information disclosure statement has been received and entered into the file. The examiner thanks the Applicants for supplying the duplicate IDS and 1449.
- (c) The third supplemental IDS filed 7/21/2003 has been received and entered into the file. A signed and initialed copy of the 1449 is attached.

### ***II. Remarks:***

- (a) Election/Restriction:

Applicants have amended their claims to limit said claims to the elected group as identified in office action of 04/21/2003.

- (b) Claims 6-12, 14-16 and 18-20 have been cancelled.
- (c) Claims 22-24 have been newly added. Claim 22 is drawn to a method of using the compounds of claim 1. No new matter has been added. Claims 23 and 24 are drawn to intermediate compounds, which do not fall within the elected group and are thus withdrawn from consideration as being drawn to non-elected inventions. 37 CFR 1.142(b).
- (d) Claims 1-5, 13, 17 and 21-24 are pending.
- (e) The objections to the claims have been overcome by the amendments and arguments presented in the response of 07/21/2003.

### ***III. Examiner's Amendment:***

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An examiner's amendment is attached to this office action that cancels claims 23 and 24 drawn to non-elected intermediates. Permission to cancel these claims has been provided by Applicants representative, Warren Cheek, Jr., on September 3, 2003.

***IV. Reasons for Allowance:***

Applicants claims relate to compounds, compositions and methods of using the compounds according to claim 1. The art of record does not teach or fairly suggest the benzofuran ring that is substituted as instantly claimed. Therefore, claims 1-5, 13, 17 and 21-22, renumbered 1-9 are allowed.

***V. Contact Information:***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.


When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

Andrea D. Small, Esq.  
September 5, 2003

Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626

  
ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

**EXAMINER'S AMENDMENT TO THE CLAIMS**

Please cancel claims 23 and 24.

*Alan L. Rotman*

ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

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Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626